

REMARKS

Applicants respectfully request that the Examiner reconsider and withdraw the restriction requirement.

According to the Examiner, the rules of practice provide that restriction is proper at any stage of prosecution up to final action, and that a second requirement may be made when it becomes proper, even though there was a prior requirement with which applicant complied.

This may be true, but *Manual of Patent Examining Procedure* § 803 is entitled “Restriction — When Proper” and provides in pertinent part:

“If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.

* * *

“There are two criteria for a proper requirement for restriction between patentably distinct inventions:

- (1) The inventions must be independent * * * or distinct as claimed * * *; and
- (2) There must be a serious burden on the examiner if restriction is not required * * *. [All emphasis added.]”

Consequently, the Examiner’s authority to insist upon restriction only extends to those situations where the failure to insist upon restriction would subject the Examiner to serious burden.

A serious search burden should not be present in the instant case. Although the Examiner is correct that Applicants' last amendment added new expression vector claims 31-36, the substance thereof has already been searched with the search of prior claim 30. Likewise, while Applicants' last amendment added new gene knockdown method claim 37, the substance thereof has already been searched with the search of prior claim 1. And, while Applicants' last amendment added new mouse claim 38, the substance thereof has already been searched with the search of prior claim 27.

In short, examining all of the current claims and species should only require the usual update searches, which, by definition, do not constitute a serious search burden on the Examiner.

In view of the foregoing, Applicants respectfully submit that the restriction requirement is improper and, therefore, Applicants respectfully request that the Examiner reconsider and withdraw it.

Early and favorable action is earnestly solicited.

Respectfully submitted,
NORRIS McLAUGHLIN & MARCUS, P.A.

By ____/Kurt G. Briscoe/
Kurt G. Briscoe
Attorney for Applicant(s)
Reg. No. 33,141
875 Third Avenue - 18th Floor
New York, New York 10022
Phone: (212) 808-0700
Fax: (212) 808-0844